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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,216	06/16/2000	Thomas E. Ward III	39674/JEC/1148	1187
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CHRISTIE, PARKER & HALE, LLP 350 WEST COLORADO BOULEVARD SUITE 500 PASADENA, CA 91105				
			EXAMINER NALEVANKO, CHRISTOPHER R	
			ART UNIT 2611	PAPER NUMBER

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/595,216

Applicant(s)

WARD ET AL.

Examiner

Christopher R Nalevanko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 09/22/03 have been fully considered but they are not persuasive. Applicant argues "Schein discloses selecting a program from a display listing and displaying a preview of the selected program in a preview window and displaying the selected program in a program area" (page 13-14 lines 26-2). Examiner agrees that Schein shows a preview window for displaying the selected program but asserts the program window is for displaying the *currently tuned program* (page 12 section 0133). This *currently tuned program* relates to the last viewed program by the user and not to program selected on the listing guide. The program on the listing guide is referred to as "the show that is currently being highlighted in show matrix 506" (page 12 section 0133).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the third area of screen". There is insufficient antecedent basis for this limitation in the claim. Claim 5 is dependent upon Claim 3.

### ***Claim Rejections - 35 USC § 102***

The following claim rejections are based on the Examiner's best understanding in light of the above 35 U.S.C. 112 2<sup>nd</sup> paragraph rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-8, 10-17, 19-21, 23-30, and 32-34 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Schein et al.

Regarding Claim 1, Schein shows a method for navigating about an on screen television interactive program guide (see fig. 16a). Schein further shows displaying a list of television programs in a first area of a screen (see fig. 16a item 506), displaying a first television program in a second area of the screen (see fig. 16a item 526), activating a display function (equating to activating the listing and moving cursor down list, page 12 section 0133), and maintaining display of the first television program in the second area of the screen responsive to a first state of the activated display function (page 12 section 0133, see fig. 16a item 526).

Regarding Claim 2, Schein shows an icon (fig. 16a, item 512) that indicates the user is in the program guide display.

Regarding Claim 3, Schein shows an icon (fig. 16a, item 512) that indicates the user is in the program guide display. This icon is overlaid in a third portion of the screen.

Regarding Claim 4, Schein further shows receiving a first user command invoking a full screen television mode from the on screen guide (page 12 section 0137, see fig. 17a-c), displaying a full screen television program in response to the first user command (page 12 sections 0131-0133, 0136-0137), receiving a second user command invoking a grid guide mode (page 12 section 0137, see fig. 17a-c), returning to the on screen program guide (page 12 section 0137), and redisplaying the first television program in the third area of the screen (page 12 section 0122, see figure 16a).

Regarding Claim 6, Schein shows that user activates the display function with a remote control (page 12 section 0131, see fig. 1).

Regarding Claim 7, Schein shows that the list of television programs in the first area is maintained (page 12 section 0133, see fig. 16a).

Regarding Claim 8, Schein shows displaying an interactive advertisement in a third area of the screen and selecting the advertisement to active an ad function (page 11 sections 0127-0128, page 12 sections 0134-0135).

Regarding Claim 10, Schein further shows being able to connect to the Internet to show images or data in the second area of the screen (page 10 section 0117, page 11 sections 0124-0125, page 12 sections 0133-0137, page 13 sections 0140-0141, see figure 21c).

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Regarding Claim 11, Schein further shows establishing a link to an internet website for display of images or video in a fourth area of the screen (see figure 21c 'official NFL cap' area).

Regarding Claim 12, Schein shows the ability to collect user profile data and change the EPG accordingly (page 11 section 0122).

Regarding Claim 13, Schein shows that the profile data includes viewer interaction with the program guide (page 11 section 0122).

Regarding Claim 14, Schein shows an interactive television system with a tuner for receiving a television program, memory for storing multiple types of data, and a display monitor coupled to the tuner and memory (page 2 section 0029, page 3 sections 0036-0037, page 4 sections 0040, 0050, page 5 sections 0054-0059). All other limitations of the Claim have been discussed with regards to the method claims of Claim 1.

Regarding Claims 15-17, 19-21, and 23-26, the system claims have been discussed with regards to the method Claims of Claims 2-4, 6-8, and 10-13, respectively.

Regarding Claim 27, all limitations of the claim have been discussed with regards to Claim 1.

Regarding Claim 28, all limitations of the claim have been discussed with regards to Claim 2.

Regarding Claim 29, all limitations of the claim have been discussed with regards to Claim 3.

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Regarding Claim 30, all limitations of the claim have been discussed with regards to Claim 4.

Regarding Claim 32, all limitations of the claim have been discussed with regards to Claim 6.

Regarding Claim 33, Schein shows using an icon to activate the display function (see fig. 16a item 512).

Regarding claim 34, Schein shows that the display list of programs in the first area of the screen maintains after the display function is invoked (see fig. 16a).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5, 9, 18, 22, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al.

Regarding Claim 5, Schein fails to show a locked lock and an unlocked lock to indicate the display state. Official Notice is given that it is well-known and expected in the art to use locks, as well as a wide variety of icons, to indicate display states.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein with the lock icons so that the state of the display

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would be graphically represented in a way such that the user would easily be aware of the current operating conditions of the display.

Regarding Claim 9, Schein shows the ability to record a future television show from the program guide (page 9 section 0109). Schein also shows the ability to advertise a future television program (page 12 section 133-134). Schein also shows the ability to perform a function on the displayed advertisement as discussed above. Schein fails to show that performing the direct function on the advertisement would mark it for recording. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein with the ability to mark a future advertisement for recording so that the user could automatically set a desired program for recording instead of searching through the program guide.

Regarding Claim 18 and 31, all limitations of the claim have been discussed with regards to Claim 5.

Regarding Claim 22, all limitations of the claim have been discussed with regards to Claim 9.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after



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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 703-305-8093. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Christopher Nalevanko  
AU 2611  
703-305-8093

cn  
December 23, 2003

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600